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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Akihiko TANIOKA et al.

Group Art Unit: 1792

Application No.: 10/546,008

Examiner: F. PARKER

Filed: June 26, 2006

Docket No.: 125080

For: IMMOBILIZING METHOD, IMMOBILIZATION APPARATUS, AND
MICROSTRUCTURE MANUFACTURING METHOD

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the August 6, 2009 Restriction Requirement, Applicants provisionally elects Group I, claims 1-24 and 27, with traverse.

A. Unity of Invention Standard

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. See MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent “*a priori*,” that is, before considering the claims in relation to any prior art, or may only become apparent “*a posteriori*,” that is, after taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* (“ISPE”) 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Furthermore, unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims, as stated in ISPE 10.06:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By “dependent” claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

See also MPEP §1850(II).

B. Failure to Establish a Lack of Unity of Invention

The Office Action asserts that Groups I, II, and III do not relate to a single inventive concept because the claims are anticipated by references cited in the international search report. The Office Action first states that four of the references are “X” references and three of the references are “Y” references (with reference to the international search report). *See*

Restriction Requirement at page 2. Next, the Office Action further asserts that the restriction requirement is proper because "electrospray of a liquid onto a supported substrate of any shape to form a functional coating of a nano thickness and apparatus for its use, as claimed, fails to define a contribution over the prior art." *See id.* These statements are insufficient to establish a lack of unity of invention.

The Office Action must "explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." MPEP 1893.03(d). The Office Action fails to describe the unique special technical feature in each group and also fails to explain why Groups I, II, and III lack unity of invention. Accordingly, the Office Action fails to meet its burden for establishing a lack of unity of invention and the restriction requirement is thus improper.

All the claims share common subject matter and, therefore, *a priori* unity of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claims are known. *See* ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of the subject matter that is common to independent claims 1, 25, and 27 is known in the prior art. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus a restriction requirement based on a lack of unity of invention is improper.

C. Conclusion

Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

Respectfully submitted,



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